

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

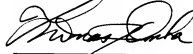
In re the Application

Inventor : **Thelen, et al.**
Application No. : **10/549,348**
Conf. No. : **6705**
Filed : **September 14, 2005**
For : **METHOD FOR TRANSMITTING A
USER-SPECIFIC PROGRAM**

APPEAL BRIEF

On Appeal from Group Art Unit 2427

Daniel Piotrowski
Registration No. 42,079



Date: January 11, 2009

By: Thomas J. Onka
Attorney for Appellants
Registration No. 42,053

TABLE OF CONTENTS

	<u>Page</u>
I. REAL PARTY IN INTEREST.....	3
II. RELATED APPEALS AND INTERFERENCES.....	3
III. STATUS OF CLAIMS.....	3
IV. STATUS OF AMENDMENTS.....	3
V. SUMMARY OF THE CLAIMED SUBJECT MATTER...	4
VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL.....	5
VII. ARGUMENT.....	6
VIII. CONCLUSION	13
IX. CLAIMS APPENDIX.....	14
X. EVIDENCE APPENDIX.....	17
XI. RELATED PROCEEDINGS APPENDIX.....	17

I. REAL PARTY IN INTEREST

The real party in interest is the assignee of the present application, Koninklijke Philips Electronics N.V., and not the party named in the above caption.

II. RELATED APPEALS AND INTERFERENCES

With regard to identifying by number and filing date all other appeals or interferences known to Appellants which will directly effect or be directly affected by or have a bearing on the Board's decision in this appeal, Appellants are not aware of any such appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-6 and 8-11 have been presented for examination. All of these claims are pending, stand finally rejected, and form the subject matter of the present appeal.

IV. STATUS OF AMENDMENTS

In response to the Final Office Action, dated August 14, 2008, Appellants timely submitted, on October 12, 2008, arguments believed to overcome the reasons for rejecting the claims. On November 3, 2008, an Advisory Action was entered into the record. The Advisory Action recited that for purposes of appeal, the amendment to claim

1 contained in the October 12, 2008 office action response would not be entered. The Advisory Action also stated that the response did not place the application in a condition for allowance. In addition, the Advisory Action provided further rationale for maintaining the rejections of the claims under 35 USC §102(e) and 35 USC §103(a). A Notice of Appeal was timely filed in response to the Advisory Action and this Appeal Brief is being filed within the period of response from the date of the Notice of Appeal.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The present invention is expressed primarily in independent claims 1 and 10. Claim 1 recites a method for transmitting a user-specific program to a user of a program content transmission system (item 1, Fig. 1), the method comprising the steps of: (a) transmitting a first part of the program content (item P, Fig. 1) of the program to a first terminal unit (item A, Fig. 1) of the user; (b) stopping the program transmission to the first terminal unit in accordance with a pre-determined procedural sequence when a first defined event occurs (paragraphs [0013] and 0014] of the published application); and, (c) transmitting a second part of the program content (item P', Fig. 1) to a second terminal unit (item B, Fig. 1) of the user when a second defined event occurs, to continue the program transmission in accordance with a predetermined procedural sequence. Claim 1 further recites that the user-specific program and/or the program content are adapted before the continuation of the transmission to the second terminal unit (paragraphs [0025] - [0027] of published application).

Independent Claim 10 recites a program content transmission system which essentially incorporates the method of claim 1.

The remaining claims, which depend from respective independent claims, express further aspects of the invention.

VI. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

The issue in the present matter is whether:

1. Claims 1, 2, 4, 5, 8, 9 and 11 are unpatentable under 35 USC §102(e) as being anticipated by Isozu, U.S. Patent No. 7,127,496.
2. Claims 3, 6 and 10 are unpatentable under 35 USC 103(a) over the combination of Isozu and Katz, U.S. Patent No. 7,103,906. Claim 6 is unpatentable under 35 USC 103(a) over Isozu in view of Bhagavath, U.S. Patent No. 6,829,781.

VII. ARGUMENT

A. 35 USC §102(e) Rejection of Claims 1, 2, 4, 5, 8, 9 and 11

Claims 1, 2, 4, 5, 8, 9 and 11 are not unpatentable under 35 USC §102(e) as being anticipated by Isozu, as Isozu fails to show material elements recited in independent claim 1.

Appellants respectfully submit that the pending claims are patentable for at least the following reasons.

Claim 1 recites:

1. A method for transmitting a user-specific program to a user of a program content transmission system comprising:
 - transmitting a first part of the program content of the program to a first terminal unit of the user;
 - stopping the program transmission to the first terminal unit in accordance with a pre-determined procedural sequence when a first defined event occurs; and,
 - transmitting a second part of the program content to a second terminal unit of the user when a second defined event occurs, to continue the program transmission in accordance with a predetermined procedural sequence;
 - wherein the user-specific program and/or the program content are adapted before the continuation of the transmission to the second terminal unit.

As recited in his Abstract Isozu et al. relates to:

A system capable of switching terminals while continuously receiving data on terminals monitored by a relay device such as a gateway. In devices such as a gateway for relaying data, the session status of the terminal under control is monitored and the relay processing status of data received externally over a network is changed according to requests such as pause, list, resume and call from a terminal, and the dynamic data address is changed or the relay of data is temporarily halted (pause). The present structure allows the user (client) to change the terminal receiving the data and change the receive processing status so that data can be continuously received on the terminal used after switching terminals.

Isozu teaches a means to resume transmission of a data stream when the receiving user terminal is changed. However, Isozu fails to address the feature of claim 1 wherein the user-specific program and/or the program content are adapted before the continuation of the transmission to the second terminal unit. In the Final Office Action dated August 14, 2008 (hereinafter, “the Final Office Action”), the Examiner points to col. 12, lines 4-36 of Isozu as teaching this feature. This section of Isozu merely shows the mechanism whereby transmission of the data was resumed with terminal B as the new receiving terminal. It merely relates to processing an address change, and in particular: “As a result, **the stream data that terminal A, 720 had received** via the gateway 710 **is received (Process (7) of FIG. 12) continuously by the terminal B, 730**” (col. 12, lines 34-36) [emphasis added].

Isozu fails to adapt program “content” as that term is used in the present invention. In particular, and as noted above, Isozu’s invention is directed to program content not being changed when the receiving terminal is switched.

The Final Office Action argues that the destination address change teaches the feature of the present invention wherein “the user-specific program and/or the program contents are adapted.” Appellants respectfully disagree, and will now address each of the two cited aspects of this claim feature:

1. Adapting “the user-specific program” (a user-specific program being defined in the discussion in paragraph [0003] of the published application) is clearly not met by Isozu’s destination address change. Paragraphs [0025] – [0028] contain examples of adapting a program that include: adaptation of the video data resolution, quality of the audio data transmission, frequency of traffic announcements. As these examples illustrate, in the present invention the program information being transmitted, Isozu’s “data,” is being changed. This is incompatible with Isozu’s invention, wherein “... **the stream data that terminal A, 720 had received** via the gateway 710 **is received** (Process (7) of FIG. 12) continuously **by the terminal B, 730**” (col. 12, lines 34-36) [emphasis added]; as noted above.

2. Similarly, Isozu’s teaching of an address change fails to meet the claim feature of “adapting the program content” as the term “content” is employed in the

present invention. By way of example, paragraph [0002] of the present invention states:

A program content transmission system refers to each system that sends preferably digital audio and/or visual contents such as films, shows, news, radio plays, music or multimedia content to its users, i.e. to its listeners and viewers respectively. The **program content can then be transmitted** in any desired way, wireless, for example via terrestrial and/or satellite-supported radio networks and/or wire-bound, for example, via broadband cables. **The program content, which is normally stored on a server of the program content transmission system** or generated "live", can be received accordingly by the users with the most varied devices and used in a most diverse way depending on the type of the program content.

Clearly, a distinction exists between changing what is being transmitted and merely changing the address to which it is sent. The Examiner maintains that a destination address is program content: "The changing of the destination address of the program content to the second terminal unit effectively adapts the program content to that second terminal unit" (Advisory Action, page 2, last 2 lines of first paragraph). In the Advisory Action the Examiner further maintained that Appellants attempt to clarify the claim's use of the word "adapted" by reference to the specification was an attempt to read "limitations from the specification" into the claim language (Advisory Action, page 2, second paragraph). Appellants respectfully disagree, as a discussion of how claim terms are defined in the specification is a valid issue that should be properly considered by an Examiner. That an applicant can be his own lexicographer is well settled – as long as the definitions he provides are not contrary to the ordinary meanings of the words involved.

Appellants submit that the feature of claim 1 which recites adapting a user-specific program relates to making changes in what is to be sent. Isozu not only fails to teach this feature, but in fact teaches away from this feature (as Isozu requires the same stream data to be continuously received by both terminals).

A claim is anticipated only if each and every element recited therein is expressly or inherently described in a single prior art reference. Isozu cannot be said to anticipate claim 1 of the present invention, because Isozu fails to disclose each and every element recited. As shown, Isozu fails to disclose the limitation that “the user-specific program and/or the program content are adapted before the continuation of the transmission to the second terminal unit” as is recited in claim 1.

In view of the foregoing, Isozu fails to teach or every feature recited in claim 1, and therefore this claim is believed to be patentable. Dependent claims 2, 4, 5, 8, 9, and 11 are patentable at least by virtue of their dependence on the patentable independent claim 1.

B. 35 USC §103(a) Rejection of Claims 3, 6 and 10

Claim 10 of the present invention, contains features similar to those of claim 1 and in particular recites the feature that “the user-specific program and/or the program content are adapted before the continuation of the transmission to the second terminal unit.” As

noted in the Final Office Action (1st full paragraph of Page 9) Katz fails to teach this feature of claim 10 of the present invention. The Final Office Action then relies on Isozu to teach this feature of the invention. For the reasons noted above, this argument is deficient as Isozu also fails to teach this feature.

It is respectfully submitted that in order to establish a *prima facie* case of obviousness, three basic criteria must be met:

1. there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings;
2. there must be a reasonable expectation of success; and
3. the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)

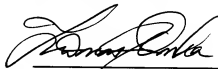
As the combination of Katz and Isozu fails to disclose each and every element claimed, Appellants submit that the reason for the Examiner's rejection of claim 10 has been overcome and can no longer be sustained. Appellants respectfully request reconsideration, withdrawal of the rejection and allowance of claim 10.

With regard to the remaining dependent claims 3 and 6, these claims ultimately depend from independent claim 1. Appellants respectfully submit that these remaining dependent claims are allowable at least for their dependence upon an allowable base claim, without even contemplating the merits of the dependent claims for reasons analogous to those held in In re Fine, 837 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988) (if an independent claim is non-obvious under 35 U.S.C. §103(a), then any claim depending therefrom is non-obvious).

VIII. CONCLUSION

In view of the above analysis, it is respectfully submitted that the referenced teaching fails to render unpatentable or anticipate the subject matter of any of the present claims. Therefore, reversal of all outstanding grounds of rejection is respectfully solicited.

Respectfully submitted,
Daniel Piotrowski
Registration No. 42,079



Date: January 11, 2009

By: Thomas J. Onka
Attorney for Appellants
Registration No. 42,053

VIII. CLAIMS APPENDIX

The claims which are the subject of this Appeal are as follows:

1. A method for transmitting a user-specific program to a user of a program content transmission system comprising:

transmitting a first part of the program content of the program to a first terminal unit of the user;

stopping the program transmission to the first terminal unit in accordance with a pre-determined procedural sequence when a first defined event occurs; and,

transmitting a second part of the program content to a second terminal unit of the user when a second defined event occurs, to continue the program transmission in accordance with a predetermined procedural sequence;

wherein the user-specific program and/or the program content are adapted before the continuation of the transmission to the second terminal unit.

2. A method as claimed in claim 1, characterized in that the first defined event comprises the reception of a transmission stop signal and/or the second defined event comprises the reception of a transmission continuation signal from an end device of the user.

3. A method as claimed in claim 2, characterized in that a time stamp is put in the program when the first event occurs or when the transmission is stopped and the

transmission of the further program content begins when the second event occurs at this time stamp or at a pre-determined distance before this time stamp.

4. A method as claimed in claim 1, characterized in that when the first event occurs first the transmission of a running program content section is terminated before a transmission stops.

5. A method as claimed in claim 4, characterized in that the running program content section is terminated in abridged form before the transmission stop.

6. A method as claimed in claim 1, characterized in that at the continuation of the program first there is a continuation prelude and/or a summary of at least a part of the program contents transmitted before the transmission stop.

7. Cancelled.

8. A method as claimed in claim 1, characterized in that the user-specific program is reorganized before the transmission is continued.

9. A method as claimed in claim 1, characterized in that the adaptation and/or a reorganization of the user specific program takes place on the basis of a user-specific and/or device profile.

10. A program content transmission system comprising:

- a program management system to render user-specific programs assigned to the respective users available to the various users of the program content transmission system,
- a number of transmission channels, for the transmission of program contents of the user-specific programs to the terminal units, of the particular users,
- a unit management system to stop the program transmission to a first terminal unit of a user in accordance with a pre-determined procedural sequence when a first defined event occurs and, when a second defined event to continue the program transmission in accordance with a pre-determined procedural sequence occurs, to cause a continuation to take place of a transmission of program contents to a second terminal unit of the user;

wherein the user-specific program and/or the program content are adapted before the continuation of the transmission to the second terminal unit.

11. A terminal unit for use in a method as claimed in claim 1, comprising a receiving facility for the reception of program contents, of a user-specific program assigned to the user of the terminal unit of a program content transmission system and comprising a module for communicating a transmission stop signal and/or a transmission continuation signal to the program content transmission system.

X. EVIDENCE APPENDIX

No further evidence is provided.

XI. RELATED PROCEEDING APPENDIX

No related proceedings are pending and, hence, no information regarding same is available.